

REMARKS

In the Final Office Action mailed April 14, 2009, claims 1-22 were pending and rejected for various reasons. No claims have been amended in this response. Reconsideration and allowance of the present application in view of the remarks that follow is respectfully requested.

Request to Withdraw Finality

The Finality of the outstanding Office Action is improper. With regard to making an Office Action final, the Manual of Patent Examining Procedure (MPEP) §706.07(a) states:

[u]nder present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In the Office Action mailed October 20, 2008, claims 13-14 stood rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,553,609 to Chen in view of Official Notice and claim 18 stood rejected under 3 U.S.C. §101. No amendments were made to these claims in the response filed February 20, 2009. In this Final Office Action, claims 13-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chen in view of U.S. Patent No. 6,101,478 to Brown, while claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Chen in view of U.S. Patent No. 5,960,405 to Trefethan. Thus, it is respectfully submitted that new grounds of rejection, which were not necessitated by any amendment, have been raised with respect to these claims. In addition, these new rejections are not “based on information submitted in an information disclosure statement.” Accordingly, the Examiner should not have made the current Office Action final in view of these new grounds of rejection. For at least the reasons set forth above, it is submitted that the finality of the current Office Action is improper and withdrawal of the holding of finality is respectfully requested.

Claim Rejections

35 U.S.C. §102 Rejections

Claims 1-12, 15-17 and 19-22 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,553,609 to Chen et al. It is well established that "an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate. For the reasons that follow, Chen does not anticipate these claims.

Contrary to assertions in the Office Action, Chen fails to disclose several features of the pending claims. Moreover, it appears the Office Action has failed to properly consider the relationship and organization of the features of the pending claims. For example, with respect to independent claim 1, Chen fails to disclose "receiving a patient follow-up request from a practitioner" and "entering data in a patient information database maintained by the server in response to the patient follow-up request." The Office Action, citing column 9, lines 33-56 of Chen, asserts that it "teaches contacting a patient by telephone in response to a predetermined event or condition" and that this disclosure teaches the step of "receiving a patient follow-up request from a practitioner." See, Office Action, page 7. This assertion is respectfully traversed. The cited portion of Chen indicates that an MMS 24 could be used for continuous, full-time monitoring of a patient, and that the patient could receive a phone call that is automatically placed in response to a predetermined event. Examples of predetermined events or conditions include patient injury, unconsciousness and death, not a request from a practitioner. See e.g., Chen, column 9, lines 45-47. Moreover, there is no indication that this phone call is a request for patient follow-up received from a practitioner. Notably, the call itself appears to be a follow-up,

not a request, and Chen fails to provide any indication with respect to the generation of the call except that it is automatically made in response to an event such as patient injury, unconsciousness and death. Moreover, the “automatic” nature of the call strongly undermines any notion that it is a patient follow-up request from a practitioner. Furthermore, even if assuming only *arguendo* the automatic phone call could somehow be construed as receiving a patient follow-up request from a practitioner, Applicant notes that Chen fails to provide any indication of entering data in a patient information database maintained by a server in response to the automatic phone call. Indeed, Chen is silent with respect to any action taken in response to the automatic phone call. As a corollary, Chen fails to disclose these features of claim 1.

Claim 1 also recites “sending the patient data to the practitioner from the patient information database.” The Office Action, citing column 16, line 65 to column 17, line 17 of Chen, asserts that it teaches “that a health care professional may obtain vital data regarding a patient from a computer (e.g., patient information database)” and that this is the equivalent of sending patient data to a practitioner from the patient information database. Contrary to the assertion of the Office Action, the cited portion of Chen does not teach that a health care professional can obtain data from a patient information database. Rather, it discloses that a variety of sensors may collect patient data “under the direction of the health care professional via the MMS computer 40.” See, Chen, column 16, line 67 to column 17, line 1. Similarly, the cited portion of Chen only discloses that a computer can be used to control the collection of data. Moreover, even if the health care professional directing the data collection with computer 40 somehow “obtains vital data regarding a patient” from computer 40, there is no suggestion that this health care professional is the same as the practitioner from which the patient follow-up request was received as specified in claim 1. Moreover, in contrast to the features described in the cited portion of Chen, the subjection application discloses, at page 11, lines 12-14, “[i]n operation 140, the patient outcome results are faxed to the corresponding health care provider site 34. The fax can be generated and sent automatically in accordance with programming of server 24 and/or 26 from site 22, or sent from administration site 38.” The subject application also discloses that computer data transmission or voice transmission via telephone may be used

as alternatives to the fax transmission. See, page 11, lines 18-21. Accordingly, it is respectfully submitted that Chen also fails to recite this feature of claim 1.

For at least the reasons set forth above, independent claim 1 is patentable over Chen. Accordingly, withdrawal of the rejection of independent claim 1 and allowance of the same are respectfully requested. Claims 2-5 depend from independent claim 1 and are patentable for at least the reasons supporting the patentability of independent base claim 1, although further reasons support the patentability of these claims. For example, claim 5 includes "providing at least a portion of the patient data to a program sponsor through the computer network." For reasons similar to those discussed above with respect to claim 1, Chen also fails to disclose providing patient data to a program sponsor. Additionally, Applicant notes that the program sponsor in claim 5 is separate and distinct from the practitioner and health care monitor recited in claim 1.

Independent claim 6 is directed to a method that includes, among other features and elements, "sending the patient data to a health care provider for the patient from the patient information database." For at least the reasons discussed above with respect to claim 1, Chen fails to disclose this feature. Claim 6 also includes "providing a server for storing a patient information database" and "generating an assignment of a patient contact to a health care monitor with the server." The Office Action suggests that Chen discloses this feature in column 6, lines 22-50 and column 11, lines 22-24. In column 11, lines 30-38, Chen discloses that Supervisory Control Center (SCC) 22 can perform, *inter alia*, database management and job scheduling. This portion of Chen does not indicate how SCC 22 performs these functions, including whether they are performed with a server. Moreover, Chen also discloses that its system includes a main database system including a first database having patient data stored therein and a second database having health care professional data stored therein and a supervisory control computer in communication with the main database system. See, Chen, column 1, line 65 to column 2, line 4. Likewise, it is clear that SCC 22 does not include a patient information database. In contrast, claim 6 includes a server for storing a patient information database and for generating an assignment of a patient contact to a health care monitor, a

combination of features that is not included by SCC 22. Thus, it appears that Chen also fails to disclose this arrangement of features of independent claim 6.

For at least the reasons set forth above, independent claim 6 is patentable over Chen. Accordingly, withdrawal of the rejection of independent claim 6 and allowance of the same are respectfully requested. Claims 7-12 and 14-15 depend from independent claim 6 and are patentable over Chen for at least the reasons supporting the patentability of independent base claim 6, although further reasons support the patentability of these claims. For example, claim 7 recites “wherein said generating is performed in response to a request from a health care provider.” As discussed above with respect to claim 1, Chen does not disclose receiving requests from a health care provider. Moreover, the Office Action asserts that the generating step of claim 7 is performed off-line since it is done in response to a request from a health care provider and is therefore not automatic. See, Office Action, page 8. The Applicant respectfully traverses this assertion and notes that claims 6 and 7, either alone or in combination, do not include any limitations which support this assertion.

As another example, claim 8 recites “wherein the patient receives a prescription from the health care provider and the request from the health care provider is generated to determine compliance of the patient with the prescription.” While Chen may disclose that its system can be used to monitor patient compliance with medical treatment (see column 9, lines 41-42), it fails to disclose that the request to perform such monitoring is made by the health care provider from whom the prescription was received, as set forth in claim 8. In an attempt to overcome this shortcoming, the Office Action asserts, on page 9:

[i]n Chen it is the health care provider who operates the MMS and therefore the Office takes the position that the request to perform such monitoring is made by the health care provider from whom the prescription was received because in Chen, the MMS system is meant to be used precisely by health care providers rather than any other parties.

This construction of Chen is respectfully traversed. Chen fails to disclose the relationship set forth in claim 8. The intended use of the MMS does not provide any determinative or probative evidence that logically supports the conclusion that a request to perform monitoring with the MMS is made by the health care provider from whom the prescription was received. Moreover,

Chen fails to provide any connection between those who operate the MMS and those who provide a prescription. Likewise, the above-referenced construction is overly broad, unsupported by the disclosure of Chen and has been made in error.

Claim 11 includes entering a patient diagnosis and one or more drug codes into the patient information database, and designating the health care monitor to be a pharmacist. Chen does not disclose entering drug codes. In an attempt to overcome this shortcoming, the Office Action speculates as to how a drug name might be entered on the system of Chen, and then asserts that Chen discloses the step of entering drug codes. See, Office Action, page 9. This assertion is respectfully traversed. The standard for anticipation is not speculation or conjecture about what references might disclose, but rather what the references disclose, either literally or inherently. Chen specifically discloses that medication screen 400 includes drug name 404 (emphasis added), thereby eliminating any cause for speculation. See, Chen, column 14, lines 56-57. Moreover, Chen fails to provide any indication that the drug name is provided as an abbreviation. Accordingly, the foregoing interpretation is overly broad and has been made in error. Claim 11 is further patentable over Chen.

Independent claim 16 is directed to a computer-accessible device that includes logic executable by a computer server to perform patient monitoring by, *inter alia*, generating an assignment of a patient contact to a health care monitor from a patient information database maintained by the server in response to a request from a health care provider and sending the patient data to the health care provider for the patient from the patient information database.

As indicated in Applicant's previous response, Chen does not expressly or implicitly disclose whether system 20 is run by logic executable by a computer server. For example, it appears that certain portions of system 20 are controlled manually, such as assigning patients to health care professionals. See e.g., Chen, column 11, lines 20-25. Additionally, for reasons similar to those discussed above with respect to claims 1 and 6, Chen fails to disclose additional features of claim 16. For example, Chen at least fails to disclose logic executable by a computer server to perform patient monitoring by "generating an assignment of a patient contact to a health care monitor from a patient information database maintained by the server in response to a request from a health care provider" and "sending the patient data to the health care provider for

the patient from the patient information database.” As discussed above, the assignment of patients in Chen does not appear to be generated from a patient information database maintained by a server where the server also generates the assignments. Moreover, because Chen does not disclose requests from a health care provider, it also fails to disclose that any assignment of a patient contact to a health care monitor is generated in response thereto. Additionally, as discussed above, there is no disclosure that the patient information in database 32 is sent to anyone.

For at least the reasons set forth above, independent claim 16 is patentable over Chen. Accordingly, withdrawal of the rejection of independent claim 16 and allowance of the same are respectfully requested. Claim 17 depends from independent claim 16 and is patentable for at least the reasons supporting the patentability of independent base claim 16.

Independent claim 19 is directed to a system that includes, among other features, a server operable to maintain a patient information database; an administrative computer; one or more practitioner computers; one or more health care monitor computers; a computer network coupled to the server, the administrative computer, the one or more practitioner computers, and the one or more health care monitor computers; and wherein the server is operable to send data about the patient response to at least one of the one or more practitioner computers from the patient information database.

Chen fails to disclose several features of claim 19. For example, the system of Chen does not include one or more practitioner computers and one or more health care monitor computers. The Office Action asserts that these features are disclosed in column 6, lines 38-43 of Chen. The only type of computers described in this section of Chen are MMS's 24 which are utilized by health care providers to perform “in-home” visits. In contrast, the subject application indicates that the one or more practitioner computers and one or more health care monitor computers are separate and distinct items. For example, the health care monitor computers are utilized by health care monitors who call patients, gather information from the patients and enter such information onto the system (see e.g., paragraphs [0027-0029] of the subject application) while the practitioner computers are utilized by health care providers to monitor their patient records to review patient outcomes or histories (see e.g., paragraph [0030] of the subject application). As

indicated above, Chen only discloses that the MMS's 24 are utilized by health care providers to perform "in-home" visits. Thus, Chen fails to disclose one or more practitioner computers and one or more health care monitor computers as those features are recited in claim 19. As a corollary, Chen also fails to disclose a computer network coupled to the server, the administrative computer, the one or more practitioner computers, and the one or more health care monitor computers.

As discussed above, Chen also fails to disclose a server that is operable to send data about the patient response to at least one of the one or more practitioner computers from the patient information database. Thus, for at least these reasons, Chen fails to disclose all the features and elements of independent claim 19.

Accordingly, withdrawal of the rejection of independent claim 19 and allowance of the same are respectfully requested. Claims 20-22 depend from independent claim 19 and are patentable for at least the reasons supporting the patentability of independent base claim 19, although further reasons also support patentability of these claims. For example, claim 20 specifies that the system also includes a program sponsor computer coupled to the computer network. With respect to this feature, the Office Action suggests that SCC 22 functions as a sponsor computer. However, the Office Action also indicates that SCC 22 functions as an administrative computer. In contrast, the system of claim 20, by way of dependency from claim 19, distinctly includes an administrative computer, one or more practitioner computers, one or more health care monitor computers and a program sponsor computer. Thus, the characterization of SCC 22 as both an administrative computer and a program sponsor computer fails to meet the limitations of claim 20. As a further example, claim 21 recites "wherein the server is operable to receive information about a request from a practitioner to follow-up with the patient and generate an assignment of at least one of the patient contacts in response to the request from the practitioner." As discussed above, Chen does not disclose receiving a request from a practitioner to follow-up with a patient.

35 U.S.C. §103(a) Rejections

As indicated above, claims 13-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chen in view of U.S. Patent No. 6,101,478 to Brown, while claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Chen in view of U.S. Patent No. 5,960,405 to Trefethan. Claims 13-14 and 18 depend from base claims 6 and 16, respectively, and are patentable for at least the reasons supporting the patentability of these base claims, although further reasons support the patentability of these claims. For example, Brown discloses an apparatus 26 that is designed to communicate queries and messages to a patient, collect measurements 44 and transmit responses 42 and measurements 44 to a server 18. Likewise, modifying Chen to include an apparatus designed to communicate queries to a patient would fail to arrive at a health care monitor asking assigned questions of the patient during the patient contact as that feature is set forth in claim 13 in combination with the other features of claim 6 from which it depends.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the subject application is in condition for allowance with pending claims 1-22. Reconsideration of the present application is respectfully requested. Timely action towards a Notice of Allowability is hereby solicited.

Respectfully submitted:

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